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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,934	08/07/2002	Axel Muntermann	(H)02MUN0018USP	9216
7590 11/23/2005			EXAMINER	
M Robert Kestenbaum 11011 Bermuda Dunes NE Albuquerque, NM 87111			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 11/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/049,934	Applicant(s) MUNTERMANN, AXEL	
	Examiner Michael Peffley	Art Unit 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 6-25, 27 and 28 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 10-25 is/are allowed.  
 6) ☒ Claim(s) 1, 2, 4, 6-9, 27 and 28 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 10/28/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Applicant's amendments and comments, received October 28, 2005, have been fully considered by the examiner of record. In particular, applicant's amendments to the specification have obviated the objection to the specification. The following is a complete response to the October 28, 2005 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 depends from claim 1 and recites the same structural limitation, therefore failing to further limit claim 1.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As amended, claims 27 and 28 fail to provide proper antecedent basis for "the ablation or mapping electrode" in line 4 of each claim.

***Claim Rejections - 35 USC § 103***

Claims 1, 2, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al ('671) in view of the teaching of Swanson et al (5,582,609).

Cunningham et al discloses an electrode with a rounded tip. As asserted previously, it is impossible to determine what constitutes a "reduced number of electrical interference centers". The Cunningham et al electrode will inherently have a "reduced" number of such centers compared to at least other electrode known in the art. It is noted that the wherein clause of claim 1 is directed to a product by process, and limited weight is given to the process of making the product (see MPEP 2113). Further, the Cunningham et al electrode is subjected to various electrolytes (e.g. saline and blood) and is made from platinum. It is noted that the Cunningham et al electrode (20) has a rounded surface structure (20b – see Figure 3). The diameter of the electrode is 2 mm, hence the radius of curvature of the rounded surface structure (20b) is 1 mm which is greater than the radius of curvature set forth in claim 1. It is noted that Cunningham et al disclose the electrode may be made from a metal such as platinum, but fail to specifically disclose the electrode is coated with platinum.

The examiner maintains that it is generally well-known in the art to make electrodes from various metals, and it is also generally known to coat the electrodes with bio-compatible metals such as gold or platinum. Swanson et al disclose another RF electrode catheter device. In particular, Swanson et al teach that the electrodes may be made from various metals, such as copper, platinum or stainless steel, or the

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electrode may be provided with a coating of platinum (col. 7, lines 33-40). The examiner maintains that the use of any well-known materials for making and or coating the electrode of the Cunningham et al device would be an obvious design consideration for one of ordinary skill in the art, particularly since Swanson et al fairly teach of the known use of various metals for making and/or coating RF electrodes.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al ('671) in view of the teaching of Eggers et al ('700).

Cunningham et al disclose a device that comprises a vessel for holding an electrolytic solution (i.e. a blood vessel containing blood) wherein the ablation and/or mapping electrodes are wetted by the electrolytic solution (i.e. the catheter is inserted into the blood vessel). A voltage-generating unit is connected to the ablation electrode, and the voltage-generating unit is external to the blood vessel. Cunningham fail to specifically teach of a second (i.e. return) electrode provided on the catheter.

Eggers et al disclose an analogous catheter device, and specifically teach that it is generally well-known in the art to provide such an electrosurgical ablation catheter with a return electrode on the catheter in proximity to the treatment electrode and in contact with a solution containing ions (i.e. saline or blood). An electric voltage is applied to the electrodes.

While it is noted that applicant's intent is to claim a much different device/process than is taught by the prior art, the claims, as presently written, are sufficiently broad so as to be obviated by the prior art as applied.

To have provided the Cunningham et al catheter as a bipolar catheter system having both active and return electrodes on the catheter body for the treatment of tissue would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Eggers et al.

***Allowable Subject Matter***

Claims 10-25 are allowed.

Claim 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

Applicant's arguments with respect to the pending claims have been fully considered and are moot in view of the new grounds of rejection.

With regard to claim 1, the examiner has applied a new reference (Swanson et al) to show that it is generally known in the art to fabricate electrodes from various metals, and that it is also known to coat the electrodes with bio-compatible metals such as platinum. Again, the examiner maintains that making the Cunningham et al electrode from any well known material and coating the electrode with any particular metal, such as elementary platinum, would be an obvious consideration for one of ordinary skill in the art in view of the teachings of Swanson et al.

Applicant contends on page 9 of the response that claim 28 was not specifically addressed in the previous Office action. The examiner disagrees. Claims 26 and 28 were previously rejected as being unpatentable over Cunningham et al in view of the teaching of Eggers et al (see previous Office action and also applicant's response at the

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top of page 9 where applicant acknowledges the rejection was made). The examiner maintains that this rejection remains tenable and has been reiterated in this instant Office action.

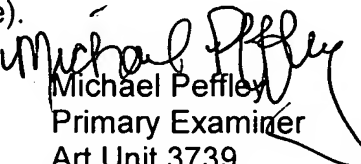
Applicant also notes on page 9 of the response that claims 1, 2, 4 and 6-31 are pending. This is not accurate as applicant has canceled claims 26 and 29-31.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
November 21, 2005